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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,468	10/27/2003	Dennis Tebbe	7162-108	2496
39207	7590	06/06/2006	EXAMINER	
SACCO & ASSOCIATES, PA P.O. BOX 30999 PALM BEACH GARDENS, FL 33420-0999			TRINH, MINH N	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/694,468	<b>Applicant(s)</b> TEBBE ET AL.	
	<b>Examiner</b> Minh Trinh	<b>Art Unit</b> 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/03, 5/16/05</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claim 1-13 in the reply filed on 4/28/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Non-elected claims 14-24 have been cancelled.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,770,159 to Tebbe et al, hereinafter '159. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully claimed in the patent and is covered by the

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patent since the patent and the application are claiming common subject matter, as follows:

Tebbe et al or the '159 claim a method for fabricating a textured dielectric substrate for an RF circuit comprising the steps of:

selecting at least a first and second dielectric board material, each having at least one electrical property distinct from the other (see claim 1, col. 6, and 16, col. 7, lines 3-5),

cutting each of said first and second dielectric board materials into a selected size and shape to form a plurality of dielectric pieces (see claim 1, col. 6, and 16, col. 7, lines 13-15),

selectively arranging said dielectric pieces on a base plate in a pattern to produce a textured substrate having at least one effective electrical property at a frequency of interest that is different from a bulk electrical property of each individual one of said dielectric board materials at said frequency of interest (claim 1, col. 6, and claim 16, lines 16-20). Noting claim 1 discloses each ceramic texture has its own property (see claim 1, col. 6, lines 20-23).

As applied to claims 2-13, limitations of these claims are similar to that as claimed by the patent '159 (see claims 2-13, col. 6).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishide et al (6,036,798) in view of Tebbe et al (6,770,159).

Nishide et al disclose a method for fabricating a textured dielectric substrate for an RF circuit comprising the steps of: selecting at least a first and second dielectric board material, each having at least one electrical property distinct from the other cutting each of said first and second dielectric board materials into a selected size and shape to form a plurality of dielectric pieces (see abstract and the discussion at col. 1, lines 58-60), selectively arranging said dielectric pieces on a base plate in a pattern to produce a textured substrate having at least one effective electrical property at a frequency of interest that is different from a bulk electrical property of each individual one of said dielectric board materials at said frequency of interest (see the discussion at col. 2, lines 49-64). Nishide et al do not teach the cutting each of said first and second dielectric board materials into a selected size and shape to form a plurality of dielectric pieces. Tebbe et al discloses the above (see the discussion at col. 4, lines 43-56, etc.).

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Therefore, one of the ordinary having skill in the art at the time of the invention was made to employ the Tebbe et al teaching of cutting each of said first and second dielectric board materials into a selected size and shape to form a plurality of dielectric pieces onto invention of Nishide et al as to form a number of work pieces.

Limitations of claims 2-3 are also met by Nishide et al (see Fig. 3).

6. Claims 1-3 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Nishide et al (6,036,798) in view of JP 09260105 hereinafter '105.

Nishide et al do not teach the cutting each of said first and second dielectric board materials into a selected size and shape to form a plurality of dielectric pieces. JP' 105 discloses the above (see the discussion at col. 4, lines 43-56, etc.). Therefore, one of the ordinary having skill in the art at the time of the invention was made to employ the JP' 105 teaching of cutting each of said first and second dielectric board materials into a selected size and shape to form a plurality of dielectric pieces onto invention of Nishide et al as to form a number of work pieces.

Limitations of claims 2-3 are also met by Nishide et al (see Fig. 3).

### ***Prior Art References***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of a method for forming RF substrate assembly or the like.

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***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mt  
5/25/06

  
**MINH TRINH**  
**PRIMARY EXAMINER**